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Or

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,258	01/06/2004	Andreas Hund	5005.1069	4048
23280	7590	06/02/2005		
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018				EXAMINER CONSILVIO, MARK J
				ART UNIT 2872 PAPER NUMBER

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/752,258	HUND ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark Consilvio	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 June 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/04 and 12/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on 1/6/2004 and 12/13/2004 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the magazine slider of claim 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 12-17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayasaka et al. (US Patent No. 6,327,079) (herein Hayasaka).

With respect to claim 1, Hayasaka discloses a tube for a microscope, comprising: an adaptation interface (not numbered); a rotatably disposed operator interface (end of 102); a beam deflecting device (150) including a beam-splitting device (106); and a rotatably disposed beam deflecting unit (109), a rotation of the operator interface being constrainedly coupled to a rotation of the beam deflecting unit (109); wherein the beam deflecting device (150) is configured to deflect, in a direction of the beam deflecting unit (109), a light beam coming from the adaptation interface (fig. 5).

With respect to claim 2, Hayasaka discloses the beam deflecting device (150) includes a deflecting prism (106) (fig. 5).

With respect to claim 3, Hayasaka discloses the deflecting prism (106) is configured to deflect by 90 degrees the light beam coming from the adaptation interface.

With respect to claim 4, Hayasaka shows the beam deflecting device (150) includes a Bauernfeind prism (108) configured to reflect therein twice the light beam coming from the adaptation interface (fig. 5).

With respect to claim 5, Hayasaka discloses the beam deflecting device (150) includes a deflecting prism (106) configured to deflect by 90 degrees the light beam coming from the adaptation interface, and wherein the Bauernfeind prism (108) is disposed between the deflecting prism (106) and the beam deflecting unit (109) (fig. 5).

With respect to claim 12, Hayasaka discloses the operator interface and the beam deflecting unit (109) are rotatable about a rotation axis, the rotation axis being perpendicular to an optical axis of the light beam (fig. 5).

With respect to claim 13, Hayasaka discloses, upon a rotation of the operator interface through a first angle, the beam deflecting unit is configured to rotate through a second angle half as large as the first angle (fig. 7).

With respect to claim 14, Hayasaka discloses a lens device (105) disposed between the adaptation interface and the beam deflecting device (150), the lens device (105) having a positive refractive power.

With respect to claim 15, Hayasaka discloses the lens device (105) is configured to convert a substantially collimated light beam into a converging light beam.

With respect to claim 16, Hayasaka discloses a lens device (103) rotatably disposed between the beam deflecting unit (109) and the operator interface (end of 102), the lens device (103) including a first lens having a negative refractive power and a second lens having a positive refractive power (fig. 5).

With respect to claim 17, Hayasaka discloses the first lens is configured to substantially collimate a light beam coming from the beam deflecting device (109).

With respect to claim 19, Hayasaka discloses the operator interface (end of 102) includes a binocular element configured for eyepiece viewing by an operator (fig. 8).

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-11 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Hayasaka (US Patent No. 5,907,432) in view of Toshimitsu (US Patent No. 5,144,478).

With respect to claims 6-8, Hayasaka discloses all the limitations of claims 1-5 as stated supra. Hayasaka does not expressly disclose the further limitations of claims 6-8. Toshimitsu discloses Bauernfeind prism may be configured such that an optical component associated with the Bauernfeind prism can be split off to a detector by cementing a prism to the Bauernfeind prism: At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Hayasaka and Toshimitsu to provide such a unit to

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allow at least a part of the light beam coming from the adaptation interface to reach a detector.

One of ordinary skill in the art would have been motivated to do this so that images can be captured and stored or transmitted for viewing at alternative locations.

Further, with respect to claims 9-11, Toshimitsu teaches that this beam splitter device may be moved into and out of a working position by a magazine slider adapting a length of an optical path of the light beam. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Hayasaka and Toshimitsu to provide this additional feature to allow an operator to increase the amount of light viewed through the microscope by de-selecting the use of the detector.

With respect to claim 18, while Hayasaka does teach an assembly (102) including the second lens and the operator interface, Hayasaka does not expressly disclose the assembly is telescopic in a direction of an optical axis of a light beam. However, such telescopic assemblies are well known in the art. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Hayasaka to allow the assembly (102) to be telescopic for a variety of reasons. One might be motivated to do this to allow the operator to extend the range of the viewer's position or adjustment of the internal optics of the assembly via telescopic manipulation of the focal length, magnification, or diopter.

### *Conclusion*

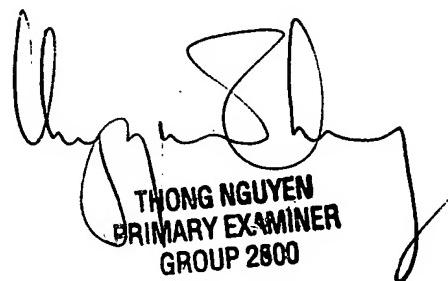
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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